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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/440,529	11/15/99	PITRODA S	2683/76979

EXAMINER	
TREMBLAY,M	
ART UNIT	**PAPER NUMBER**
2876	

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DATE MAILED: 12/21/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

1- File Copy

Office Action Summary

Application No.	Applicant(s)
09/440,529	Pitroda et al.
Examiner	**Group Art Unit**
Tremblay	2876

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 1-43 is/are pending in the application.

Of the above claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-43 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 11 9(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received: _____.

Attachment(s)

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4

☐ Interview Summary, PTO-413

☒ Notice of Reference(s) Cited, PTO-892

☐ Notice of Informal Patent Application, PTO-152

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Other _____

Office Action Summary

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-43 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-43 of copending Application No. 09/587,998. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1-3, 9-11, 25, 31, 36, and 40 are rejected under 35 U.S.C. § 102(b) as being

clearly anticipated by U.S. Patent #5,590,038 to Pitroda (" '038 " hereinafter).

Claims 1-5, 18-19, and 40-41 are rejected under 35 U.S.C. § 102(e) as being clearly anticipated by U.S. Patent #5,955,961 to Wallerstein (" Wallerstein " hereinafter).

Claims 1-5, 7-8, 11, 18-20, and 40-43 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by U.S. Patent 4,701,601 to Francini et al. ("Francini" hereinafter).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
>
> This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 6, 9-17, are rejected under 35 U.S.C. § 103 as being unpatentable over Wallerstein.

Re claim 6, duplication of parts is, in this instance, an obvious variation. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to provide a plurality of electromagnets in order to provide multiple regions of magnetic stripe emulation, so that either redundancy for reliability, or multiple stripes, or multiple regions within a stripe can be covered by the emulation function, because redundancy for reliability is a common

consideration, the magnetic stripe region is known to traverse the entire card, and known international standards use multiple stripe regions, that are in physically distinct locations on the card.

Re claims 9-11, 21-22, the claims recite commonly known I/O. Wallerstein teaches I/O port 53, for which it would have been obvious to use any of the recited technologies to transmit data, because these technologies all have well known advantages.

Re claims 12, Official Notice is taken that data buffers are old and well known in the art. See In Re Malcolm 1942 C.D.589:543 O.G. 440. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to provide data buffers connected to the processor because the processor may be busy doing other tasks at the instant the data arrives, or is due to be output. This is a fundamental part of most computer systems.

Re claim 13, 16, 23, Official Notice is taken that time out circuits are old and well known in the art. See In Re Malcolm 1942 C.D.589:543 O.G. 440. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to provide a time out circuit to the Wallerstein invention, because this would save battery power, as is well known in the art. This would function such that the data buffer would be purged (turned off, and the data erased) after a predetermined period of time.

Re claim 14, 17, 24 data is typically purged from a buffer after one data operation.

Re claims 25-28, 31 while Wallerstein does not disclose the exact method, the recited steps follow from the disclosure in an obvious manner. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to use the Wallerstein device to effect the method recited by Applicant because this is the intended use of Wallerstein, as is apparent from a fair reading of the disclosure.

Claims 25-31, are rejected under 35 U.S.C. § 103 as being unpatentable over Francini.

Re claims 25-31 while Francini does not disclose the exact method, the recited steps follow from the disclosure in an obvious manner. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to use the Francini device to effect the method recited by Applicant because this is the intended use of Francini, as is apparent from a

fair reading of the disclosure.

Internet

PTO maintains an extensive web site at http://www.uspto.gov. Communications about this application via e-mail, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be addressed to **mark.tremblay@uspto.gov**. All Internet e-mail communications will be recorded in the application. PTO employees don't use the Internet to exchange sensitive information unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. For more details, see the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Voice

General inquiries or status inquiries about this application should be directed to the Group 2800 Receptionist at (703) 308-0956. Inquiries for the Examiner should be directed to Mark Tremblay at (703) 305-5176. The Examiner's regular office hours are 9:30 am to 6:00 pm EST Monday to Friday. Voice mail is available. If Applicant has trouble contacting the Examiner, the Supervisory Patent Examiner, Don Hajec, can be reached on (703) 308-4075. Technical questions and comments concerning PTO procedures may be directed to the Patent Assistance Center hotline at 1-800-786-9199 or (703) 308-4357.

Fax Procedures

Application papers may faxed to Art Unit 2876 at (703) 308-7724. Faxes must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). Papers solely for the examiner's consideration, and not intended for immediate entry into the application (e.g., a proposed amendment) should be unsigned and clearly marked "Draft Copy" and/or "Deliver Directly to Examiner."

Mark Tremblay
December 15, 2000

MARK TREMBLAY
PRIMARY EXAMINER